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Filed: March 22, 2004
TC Art Unit: 3644
Confirmation No.: 1513

REMARKS

In the most recent Office Action, claims 1-6, 12, 15, 17-19 and 21-41 were examined. Claims 23-26 and 31-41 are withdrawn from consideration. Claims 1-6, 12, 15, 17-19, 21-22 and 27-30 are rejected.

In response, claims 39 and 41 are canceled. Claims 1-2, 4-5, 12, 15, 17-19, 21-22 and 27-30 are amended. Claims 43-43 are added. Accordingly, claims 1-6, 12, 15, 17-19, 21-38, 40 and 42-43 are pending in the present application. No new matter is added.

Applicant responds to the comments in the Office Action as follows.

Election/Restrictions

The most recent Office Action discusses traversal of an election of species. However, the Office Action dated September 26, 2005 poses a restriction based on different inventions. In Applicant's response dated October 21, 2005, Applicant elected the claims of Group I with traverse. The Office Action dated January 13, 2006 appears to acknowledge traversal of the restriction requirement and Applicant has requested further clarification. Because the most recent Office Action is silent on the status of

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the traversal of the restriction requirement, Applicant submits that the Office Action implicitly acknowledges the traversal of the restriction requirement. Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn for all the reasons provided in the response dated April 13, 2006.

Claim Rejections - 35 U.S.C. § 102

The Office Action states that claims 1-2, 4-6, 12, 15, 17-19, 21-22 and 28-30 are rejected under 35 U.S.C. § 102(b) as being anticipated by JP1-108926 (JP '926). In particular, the Office Action states that JP '926 teaches each and every element of the rejected claims. Applicant respectfully traverses the rejection.

JP '926 appears to disclose trays for growing plants, where the tray includes a lower container 1 and an upper container 2. The lower container has holes bored through a bottom of the container, and the upper container 2 has two open ends to permit plants to grow along the height of container 2. Accordingly, JP '926 fails to disclose a number of elements recited in the claims of the present application. For example, claim 1 recites:

the inner box having a bottom wall and at least one closed side wall, and being configured to be partly fillable with water.

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Because neither of the containers 1 or 2 described in JP '926 are capable of being filled with water, they cannot perform the function of containing water, as is recited in claim 1 with respect to the inner box. The remaining claims rejected under 35 U.S.C. § 102(b) over JP '926 all ultimately depend upon claim 1, and therefore include limitations not found in the cited prior art reference.

Because the cited prior art reference of JP '926 does not teach each and every claim element of claims 1-2, 4-6, 12, 15, 17-19, 21-22 and 28-30, Applicant respectfully submits that the rejection of those claims under 35 U.S.C. § 102(b) is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action apparently takes the position that recitations found in claims 1-2, 4-6, 12, 15, 17-19, 21-22 and 28-30 are intended use statements or method limitations that do not patentably distinguish the claimed structure over that of the reference. The position taken in the Office Action is contrary to established case law and without support.

As noted above, claims 1-2, 4-6, 12, 15, 17-18, 21-22 and 28-30 include structural limitations that distinguish those claims over the disclosure of JP '926. For example, claim 1 recites that the inner box and first inner box holder are detachably coupled.

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As the Office Action points out, the term "coupled" is sufficient to define a structural limitation as indicated by the cited definition of the term in the American Heritage Dictionary of the English Language, e.g., something that joins or connects; a link.

It is well established that the features of an apparatus may be recited in a claim either structurally or functionally. A claim for an apparatus may be distinguished from the prior art in terms of structural limitations. See, e.g., *In re: Schreiber*, 128 F.3d 1473, 1477-78, 44 U.S.P.Q.2d 1429, 1431-32 (Fed. Cir. 1997); MPEP § 2114. A functional limitation does not, in and of itself, render a claim improper. *In re: Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (CCPA 1971); MPEP § 2173.05(g). Accordingly, any functional language that may be recited in the present claims should be acceptable, and the position taken in the Office Action that the functional limitations are statements of intended use or method limitations is inappropriate and without support. Moreover, Applicant submits that claims 1-2, 4-66, 12, 15, 17-18, 21-22 and 28-30 recite structural limitations that distinguish the present invention over the disclosure of JP '926.

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Claim Rejections - 35 U.S.C. § 103

The Office Action states that claims 3 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '926. In particular, the Office Action states that while JP '926 does not disclose a second inner box holder different from the first inner box holder, the same would have been obvious as a matter of design choice. Applicant respectfully traverses the rejection.

Claims 3 and 27 both recite a second inner box holder coupled to or positioned in relation to the inner box in conjunction with the first inner box holder. JP '926 fails to disclose or suggest a second inner box holder coupled to the inner box or used in conjunction with the inner box and the first inner box holder. Accordingly, JP '926 fails to disclose or suggest all the claim limitations recited in claims 3 and 27. Because the cited prior art reference does not disclose or suggest all the claim limitations found in the rejected claims, Applicant respectfully submits that the rejection of those claims under 35 U.S.C. § 103(a) over JP '926 is overcome, and respectfully requests that it be reconsidered and withdrawn.

The Office Action also characterizes functional limitations found in claims 3 and 27 as method limitations or statements of intended or desired use. As discussed above, the position taken

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in the Office Action is contrary to established case law and without support.

As noted in the previous Office Action, the term "coupled" is sufficient to define a structural limitation as indicated by the cited definition of term in the American Heritage Dictionary of the English Language, e.g., something that joins or connects; a link. Moreover, Applicant notes that it is well established that features of an apparatus may be recited in a claim either structurally or functionally. A claim for an apparatus may be distinguished from the prior art in terms of structural limitations. Applicant submits that the limitations of "detachably coupled" recites a structural relationship between the inner box and the first or second inner box holder. The tray apparently disclosed in JP '926 fails to disclose or suggest such a relationship, and is incapable of permitting such a relationship to exist. Accordingly, applicant submits that claims 3 and 27 recite a number of limitations not taught or suggested in the cited prior art reference, and to the extent that claims 3 or 27 recite any functional limitations, these recitations are not method limitations or statements of intended use.

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Conclusion

Claims 42-43 are added to recite subject matter that Applicant has a right to claim. Entry and consideration on the merits is respectfully requested.

In view of the above amendments and discussion, Applicant respectfully submits that the present application is now in condition for allowance, and earnestly solicits notice to that effect.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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